

CASE FR-7295
Appl No. 10/762,787

REMARKS

Restriction has been required to one of the following inventions identified as to subject matter as follows:

- I. Claims 1-35, drawn to fiber or filament, classified in class 428, subclass 1+.
- II. Claims 36, drawn to masterbatch, classified in class 525, subclass 100+.
- III. Claims 37-68, drawn to process of forming fibers, classified in class 19, subclass 1+.
- ~~IV. Claims 69-72, 77 and 78, drawn to polymer composition, classified in class 524, subclass 80+.~~
- V. Claims 73-76, drawn to a process of forming fibers, classified in class 19, subclass 1+.

The Action states that the inventions are independent or distinct for reasons given in the Action and have acquired a separate status in the art in view of their separate classification.

The Requirement for Restriction is hereby respectfully traversed.

First of all, we call attention to MPEP Section 803, second paragraph, which states:

If the search and examination of all the claims given in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

Please note that the MPEP does not refer merely to a burden, but a serious burden. The Action does not contend that a serious burden exists here, and thus examination of the entire application on the merits is requested.

Secondly, the fee for the claims over 20 and for the independent claims in excess of 3 has been paid to the Office, and thus the Office has been reimbursed for whatever extra time it might take to examine all of the claims on the merits. In this connection, it is respectfully submitted that the Requirement for Restriction if maintained would contravene the legislation enabling the PTO to charge additional fees for such things as independent claims over three, and total claims over 20. In particular, Historical and Revision Notes for the 1980 amendment to 35 U.S.C. §41(a) to (g), is discussing Public Law 96-517, reads in part as follows:

1980 - Pub. L. 96-517 in revising fee provisions by substituting subsecs. (a) to (g) for prior subsecs. (a) to (c) required the Commissioner to establish fees based on recovery of estimated average cost of processing applications . . .

Such fees have been paid. Yet if this requirement for restriction is maintained, the Office would be recovering fees that are not based on recovery of estimated average cost of

CASE FR-7295
Appl No. 10/762,787

processing the applications, contrary to the expressed intention of the enabling legislation itself.

Thus it is requested that the requirement for restriction be reconsidered and withdrawn, and that all claims in this case be examined on the merits. In this connection, it is noted that Groups III. and V. are both drawn to "process of forming fibers, classified in class 19, subclass 1+." Thus, it appears that there are four groups involved rather than five

In order to be fully responsive, Applicants provisionally elect with traverse the subject matter of Group I (Claims 1-35) for further prosecution in this Application if the Requirement for Restriction is maintained.

In paragraph 7 of the Action, it is stated that the claims include claims directed to patentably distinct species, namely "the specific thermoplastic polymers in the blends when required." Accordingly, Applicants have been required to elect a single disclosed species, Claims 1 and 37 being referred to as the generic claims relating to such species.

Applicants respectively traverse this Election of Species requirement. As noted above, the fee for the claims over 20 and for the independent claims in excess of 3 has been paid to the Office, and thus the Office has been reimbursed for whatever extra time it might take to examine all of the claims on the merits. In this connection, it is respectfully submitted that the requirement for election of species if maintained would contravene the legislation enabling the PTO to charge additional fees for such things as total claims over 20. Since the matter is clearly discretionary with the Office, it is not seen why an election of species should be made in a case such as this where a limited number of species has been set forth.

Moreover, the filing fee paid in this application includes money for conducting a search of reasonable scope. As stated in 37 CFR 1.104(a)(1):

On taking up an application for examination . . . the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the claimed invention. The examination shall be complete with respect both to compliance of the application . . . with the applicable statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

With all due respect, an examination, say, of 18 claims with only one independent claim and

CASE FR-7295
Appl No. 10/762,787

one specific type of thermoplastic polymer does not appear to comply with the requirements of "a thorough study" or "a thorough investigation" or a complete examination, all as set forth in the Code of Federal Regulations, and as paid for on behalf of the Applicants. Note in this connection that the filing fee submitted in this application was for 78 claims and 5 independent claims. Further, it is Applicants' understanding that electronic searching capabilities have been made available to the Examining Corps for search purposes and thus laborious manual searching is no longer required.

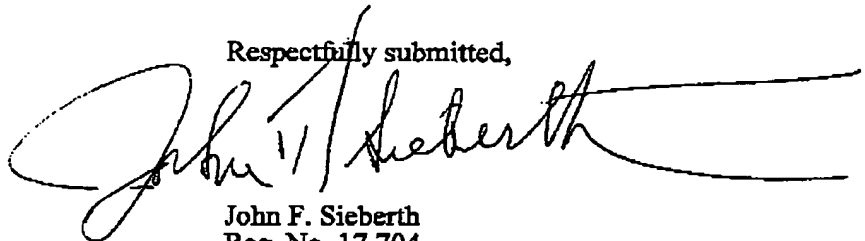
Accordingly, the Examiner is requested to reconsider and withdraw the requirement for election of species.

In order to be fully responsive, Applicant provisionally elects with traverse the species of polyester (in lieu of polyamide or polyolefin, if this is the type of species referred to in the Action) or polyethylene terephthalate (if an ultimate species is intended for election in the Action). The claims readable on these elected species are Claims 1-3, 9-11, 16-23, and 28-31.

Favorable action is solicited. If matters remain requiring further consideration that may be expedited by discussion, the Examiner is requested to telephone the undersigned at the number given below so that such matters may be discussed and, if possible, promptly resolved.

Please continue to address correspondence in this application to Mr. Spielman at the address of record.

Respectfully submitted,



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